REMARKS

I.   35 U.S.C. § 102(b) Rejections

Independent Claims 3, 7, 15, 37, 39, and 88 were rejected under 35 U.S.C. § 102(b) as being anticipated by a WIPO patent document corresponding to U.S. Patent No. 6,157,948 to Inoue et al. Because Inoue et al. does not teach each and every element recited in the independent claims, Applicants respectfully request reconsideration and withdrawal of the rejections of those claims and their dependent claims.

A.   Independent Claims 3, 7, 15, and 88

Independent Claims 3, 7, 15, and 88 each recite that the host device requires the program code stored in a solid-state memory device to read data stored in the solid-state memory device. Inoue et al. does not teach this element.

In the Office Action, it was asserted that Inoue et al. teaches an audio-video player, which presumably corresponds to the recited host device, and a storage unit storing program code and additional program segments. According to the Office Action, the program code in the storage unit is used to fetch the additional program segments in the storage unit and provide them to the audio-video player. However, the fact that the program code is written to fetch the program segments in the storage unit does not mean that the audio-video player cannot otherwise read the program segments in the storage unit. The audio-video player, on its own, may not be able to perform the exact function performed by the program code, but there is no cited teaching that the audio-video player *requires* the program code to read the program segments. Accordingly, Inoue et al. is not sufficient to anticipate independent Claims 3, 5, 7, and 88. As such, Applicants respectfully request reconsideration and withdrawal of the rejections of those claims and their dependent claims.

B.   Independent Claims 37 and 39

Independent Claim 37 recites using program code stored in a solid-state memory device to store data *only in* the solid-state memory device, and independent Claim 39 recites a solid-state memory device comprising program code operative to enable a host device to store data *only in* a certain portion of the solid-state memory device. Inoue et al. does not teach these elements.

In the Office Action, it was asserted that Inoue et al. teaches an audio-video player and a storage unit storing program code. According to the Office Action, the program code in the storage unit can be used by the audio-video player to write code in the storage unit. Even under this characterization of Inoue et al., Inoue et al. does not teach that the program code enables the audio-video player to store data *only in* the storage unit. The fact that the program code in Inoue et al. allows the audio-video player to store data in the storage unit does not mean that the program code enables the audio-video player to store data *only in* the storage unit. In fact, Inoue et al. teaches the opposite. As pointed out by the Examiner, col. 37, lines 12-26 describe different forms of the storage medium. One of those forms is a *read only* memory (ROM). If program code were written in a ROM, the program code would necessarily need to write data in a device other than the ROM (because it is read only). Accordingly, the program code necessarily is not operative to store data *only in* the memory device that contains the program code, as recited in independent Claims 37 and 39. Thus, Inoue et al. is not sufficient to anticipate independent Claims 37 and 39, and the rejections of those claims and their dependent claims should be withdrawn.

II.   35 U.S.C. § 103(a) Rejections

Independent Claims 16, 21, 24, 28, 33, 89, 90, and 91 were rejected under 35 U.S.C. § 103(a) as being unpatenable in view of the proposed combination of Inoue et al., U.S. Patent No. 6,141,756 to Bright et al., and U.S. Patent No. 6,308,317 to Wilkinson et al. Applicants respectfully request reconsideration and withdrawal of these rejections for at least the reasons set forth below.

A.   Independent Claims 16 and 89

Independent Claims 16 and 18 each recite that the host device requires the program code stored in a solid-state memory device to read data stored in the solid-state memory device. Inoue et al. was relied upon for this teaching. However, as discussed above, Inoue et al. does not teach this element.

In the Office Action, it was asserted that Inoue et al. teaches an audio-video player and a storage unit storing program code and additional program segments. According to the Office Action, the program code in the storage unit is used to fetch the additional program segments in the storage unit and provide them to the audio-video player. However, the fact that the program code is written to fetch the program segments in the storage unit does not mean that the audio-video player cannot otherwise read the program segments in the storage unit. The audio-video player, on its own, may not be able to perform the exact function performed by the program code, but there is no cited teaching that the audio-video player *requires* the program code to read the program segments.

For at least this reason, the proposed combination fails to render independent Claims 16 and 89 and their dependent claims unpatentable.

B.   Independent Claims 21, 24, 28, 33, 90, and 91

Independent Claims 21, 24, 28, 33, 90, and 91 each recite an element relating to a memory device storing encrypted program code and an identifier. A host device can decrypt the encrypted program code using the identifier. In this way, the program code is "tied" to the memory device. That is, the program code can be decrypted on any host device as long as the program code is coming from the memory device (because the memory device provides the identifier needed to decrypt the program code along with the program code). If, however, the program code is copied to a different memory device, which would not have the same identifier, the host device would not be able to decrypt the program code because the different memory device would only provide the program code and not the identifier needed to decrypt the program code. The Office Action admitted that this element was not shown in Inoue et al. and relied upon Bright et al. and Wilkinson et al. in an attempt to cure this deficiency. However, one skilled in the art would not have been motivated to make the proposed combination because it would change the basic operating principle of Bright et al.

Bright et al. is concerned about a processor executing an untrusted program from an external source. To ensure that only trusted programs are executed, Bright et al. describes a system in which trusted programs are encrypted with a key that is embedded in the processor. Since only trusted sources will have knowledge of the key, the processor can be assured that any program that is decrypted by the processor's key is from a trusted source and, therefore, safe to execute. However, Bright et al. stores its identifier in the processor and not in the memory device that provides the program code, as recited in independent Claims 21, 24, 28, 33, 90, and 91. Wilkinson et al. purportedly teaches encrypting an application on a card with an identifier stored on the card. However, one skilled in the art would not have been motivated to combine

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Bright et al. and Wilkinson et al. because moving the key from the processor to the memory device would change the basic operating principle of Bright et al.

As discussed above, by using a key embedded in the processor, the processor in Bright et al. knows that any program that can be decrypted using the key is from a trusted source and is, therefore, safe to execute. Under the proposed combination, the key would be moved from the processor to the memory device that provides the program. This eliminates the processor's ability to "check" the trustworthiness of the program and creates a "fox guarding the hen house" situation by delegating security (the key) to the very entity that Bright et al. is trying to guard against (the provider of the program code). Instead of the processor knowing that a program is safe because it is able to unlocked the program with the processor's key, the processor would have no assurances that the provided program is safe. This reintroduces the very problem that Bright et al. sought to overcome.

Because the proposed combination would change the basic operating principle of Bright et al., one skilled in the art would not have been motivated to make the proposed combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections of independent Claims 15, 33, 37, 39, 88, and 91 and their dependent claims.
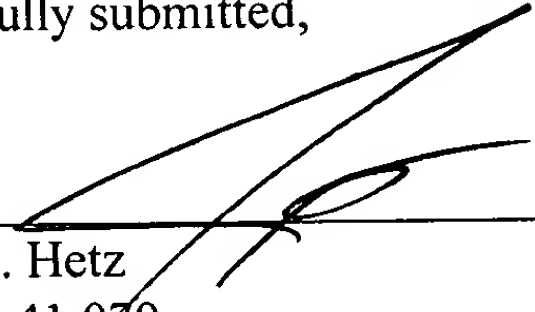
III. Conclusion

In view of the foregoing remarks, Applicants respectfully submit that this application is in condition for allowance. Reconsideration is respectfully submitted. It should be noted that while only some elements of the independent claims were discussed above, other elements of the independent claims, as well as the dependent claims, provide additional grounds of patentability. Applicants reserve the right to present these additional grounds at a later time, if necessary.

If there are any questions concerning this Response, the Examiner is invited to contact the

undersigned attorney at (312) 321-4719.

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